

Serial No. 09/967,218

Docket No.: KCC-15,529

I. APPLICANTS ARE ENTITLED TO A NON-FINAL OFFICE ACTION ON THE MERITS

Pursuant to the Request For Continued Examination filed on 14 February 2006, Applicants are entitled to receive a non-final Office Action on the merits, and an opportunity to respond with amendments not limited by the after-final restrictions if the Examiner is not willing or ready to allow the patent application.

Pursuant to MPEP 706.07(h):

The action immediately subsequent to the filing of an RCE with a submission and fee under 37 C.F.R. 1.114 may be made final only if the conditions set forth in MPEP § 706.07(b) for making a first action final in a continuation application are met (emphasis added).

Pursuant to MPEP § 706.07(b):

The claims of a new application may be finally rejected in the first Office Action in those situations where (A) the new application is a continuation of, or a substitute for, an earlier application, and (B) all claims of the new application (1) are drawn to the same invention claimed in the earlier application, and (2) would have been properly - finally rejected on the grounds and art of record in the next Office Action if they had been entered in the earlier application (emphasis added).

In the present application, the Amendment filed 12 January 2006 was not entered until after the Request For Continued Examination was filed. The amendment replaces "comprising" with "consisting essentially of" language, and removes a limitation directed to the fiber being either spunbond or meltblown. Because these claim amendments were not entered prior to the Request for Continued Examination, the amended claims presented for consideration are not drawn to the same invention as the claims previously considered.

Accordingly, Applicants are entitled to at least one non-final Office Action addressing the amended claims, and at least one opportunity to further amend the claims without the restrictions attached to after-final practice if the Examiner fails to allow the claims.

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II. THE FINAL REJECTION IS CONTRARY TO THE FACTS AND LAW

The rejection of Claims 1, 4-11, and 20-23 under 35 U.S.C. §103(a) as being unpatentable over Gutweiler et al. (U.S. Patent No. 5,514,752, hereinafter "Gutweiler") is respectfully traversed.

Applicants maintain that Gutweiler fails to disclose or suggest fibers *consisting essentially of polypropylene blended with an impact modifier*, wherein the impact modifier has elastomeric properties and is selected from a limited group, as recited in Applicants' Claims 1 and 20. In particular, the inclusion of polyvinyl butyral, as required by Gutweiler, would place a composition outside of the "consisting essentially of" language.

As explained in the Supplemental Response filed 14 February 2006, the basic and novel characteristics of Applicants' claimed impact modified fibers are the lack of melt elasticity combined with plasticization for improved fabric softness. More particularly, the lack of melt elasticity contributes to softness by reducing roping and entanglement of fibers, while the plasticization effect contributes to softness by reducing the hardness and brittleness of fibers. A prior art additive that undermines or defeats this combination of properties would be excluded by the "consisting essentially of" claim language.

As shown in Tables 2, 5 and 6 of the Examples, fibers made using the impact modified polypropylene blends of the invention had improved softness (reflected in lower cup crush loads and energies) compared to the Control fiber samples of polypropylene alone. Thus, the specification provides clear evidence that improved softness (combined with other supporting features) is a basic and novel characteristic of the claimed impact modified fibers. Contrary to the Examiner's assertion, the comparison between fibers made from polypropylene and those made from a blend of polypropylene and EPDM in Examples in Tables 2, 5, and 6 is support for the claim language of "consisting essentially of."

While the impact-modified polypropylene fibers of Applicants' invention are characterized by improved softness, a primary objective of Gutweiler et al. is to provide polyvinyl butyral-containing compositions having high rigidity and hardness.

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The stated features of high rigidity and hardness would plainly defeat, and/or materially affect, the improved fabric softness achieved by Applicants.

Although Applicants' claims do not explicitly recite these properties, i.e., improved fabric softness, Applicants' claims do recite a composition that is not disclosed or suggested by Gutweiler. Applicants bring these properties to the Examiner's attention in order to show how Applicants' claimed composition differs from the composition in Gutweiler. Since Gutweiler strives to achieve a completely different result, i.e., hardness, there is no suggestion or motivation in Gutweiler to modify the composition in Gutweiler to achieve Applicants' claimed invention.

Since the novelty of Gutweiler is the inclusion of polyvinyl butyral in polypropylene compositions, there is no suggestion or motivation to modify the Gutweiler compositions to achieve Applicants' claimed fibers. The fact that Gutweiler attributes the basic and novel characteristics, namely the high rigidity and hardness of the composition, to the addition of polyvinyl butyral is "factual evidence" that the inclusion of polyvinyl butyral in a polypropylene molding composition materially affects the basic and novel characteristics of the composition in such a way that there is no suggestion or motivation to remove the polyvinyl butyral from the Gutweiler composition because doing so would be repugnant to the teachings of Gutweiler.

As pointed out in the Supplemental Response filed 14 February 2006, a case on point is In Re De Lajarte, 337 F.2d 870, 143 USPQ 256 (CCPA, 1964), in which the Court stated that the Examiner has the burden of establishing a motivation for modifying the prior art reference to make the claimed invention. Similar to the fact pattern in In Re De Lajarte, the Examiner in the instant prosecution has failed to suggest any reason for omitting one of the primary elements (i.e., polyvinyl butyral) from the prior art composition. Furthermore, the Examiner has produced no evidence that the impact-modified polypropylene of Gutweiler possesses improved softness, which is a primary feature of Applicants' claimed composition. Gutweiler teaches that the opposite is true, and the disclosed composition is hard and brittle.

Accordingly, the rejection of Claims 1, 4-11, and 20-23 under 35 U.S.C. §103(a) should be withdrawn.

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III. THE RESTRICTION REQUIREMENT WAS IMPROPER

Applicants maintain their traversal of the restriction requirement mailed 14 July 2004, to which Applicants replied on 05 August 2004. Applicants' basis for traversal is that the Examiner previously issued four separate Office Actions in which all of the claims, including all of the species, had been examined. Thus, the Examiner has shown that the search and examination of the entire application was made (four times) without serious burden.

The Examiner indicated that this reasoning was not found persuasive because the Examiner recognized that a restriction requirement would be proper upon the amendments filed 05 April 2004 (actually 02 April 2004). Applicants disagree that the amendments filed 02 April 2004 provide any independent or distinct inventions that were not previously included in the claims. In fact, these amendments are summarized as follows:

- the elimination of two members from the Markush group in Claim 1,
- the explicit limitation in Claim 1 of the impact modifier having elastomeric properties,
- the limitation of the fibers comprising at least 75% by weight polypropylene in Claims 1, 12, and 20.

Instead of providing any independent or distinct inventions, the amendments filed 02 April 2004 narrowed the scope of the claims, and further unified these claims. Thus, Applicants maintain that the restriction requirement mailed 14 July 2004 was improper, and respectfully request the Examiner's consideration of Claims 12-19.

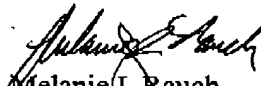
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IV. CONCLUSION

For the reasons explained above, Applicants fully believe that the claims are patentable over the prior art and in condition for allowance. If the Examiner disagrees, then Applicants request at least one opportunity to respond to a non-final Office Action (pursuant to the Request For Continued Examination), free of the restrictions imposed by after-final procedures.

Respectfully submitted,


Melanie I. Rauch
Registration No. 40,924

Pauley Petersen & Erickson
2800 West Higgins Road, Suite 365
Hoffman Estates, Illinois 60195
(847) 490-1400
FAX (847) 490-1403

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